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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 08/997,202 | 12/23/1997 | GERALD L. MYERS | 1-5703 | 1020 |

27210 7590 06/14/2002

MACMILLAN, SOBANSKI & TODD, LLC
ONE MARITIME PLAZA - FOURTH FLOOR
720 WATER STREET
TOLEDO, OH 43604

EXAMINER

PIAZZA, GLADYS J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1733

DATE MAILED: 06/14/2002

27

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/997,202

Applicant(s)

MYERS, GERALD L.

Examiner

Gladys J. Piazza

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-42 and 44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-42 is/are allowed.
- 6) ☒ Claim(s) 44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 7, 2002 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 44 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 44 recites that a second portion of adhesive material "**is not disposed from**" between the rotatably unbalanced driveshaft and the balance weight. However, the entire specification clearly recites that the second portion of adhesive (extruded portions 45a and 45b) that is initially cured is extruded from between the driveshaft and the balance weight. There is no disclosure that this portion of adhesive is **not** disposed from between the driveshaft and the balance weight. It is suggested to amend the claim to include language as recited in the specification.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 44 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 44 recites the limitation that a second portion of adhesive material **"is not disposed from"** between the rotatably unbalanced driveshaft and the balance weight. It is unclear whether Applicant intends to claim that the second portion is between the driveshaft and the balance weight or that the second portion just does not extend from between the driveshaft and the balance weight, or that the adhesive is not disposed between the driveshaft and the balance weight (in which case Applicant should delete the term "from").

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art taken with the conventional state of the art as evidenced by Duck et al. (US Patent No. 5,064,494), Challenger et al. (US Patent No. 4,528,057) and Wakabayashi et al. (US Patent No. 4,293,363) for the reasons as set forth in paragraph 6 of the prior Office Action, paper number 14.

New claim 44 adds the limitations that the driveshaft is unbalanced for rotation about an axis and that the second portion of adhesive material is not disposed from

between the driveshaft and balance weight (as opposed to the second portion of adhesive material being extruded from between the driveshaft and balance weight as recited in former claim 43). The Admitted Prior Art discloses providing a driveshaft that is unbalanced for rotation about an axis in the method of balancing a driveshaft (page 1, line 26 to page 2, line 20). As to the limitation that the second portion of adhesive material is not disposed from between the driveshaft and balance weight, this limitation is unclear, however, it appears to read on a second portion of adhesive that is between the driveshaft and balance weight. In that case, the exemplified references of the conventional state of the art (Duck et al., Challenger et al. and Wakabayashi et al.) all show examples of initially curing second portions of adhesive that are disposed only between the two adhered articles. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to balance a drive shaft by the method shown in the admitted prior art by initially curing a portion of the adhesive between the driveshaft and the balance weight prior to full curing of all the portions of adhesive as is conventional state of the art and exemplified by Duck, Challenger and Wakabayashi in order to improve and increase the flow and speed of production in manufacturing.

Allowable Subject Matter

9. Claims 25-42 are allowed for the reasons as set forth in paragraphs 6 and 7 of the prior Office Action, paper number 18.

Response to Arguments

10. Applicant's arguments filed July 30, 2001 have been fully considered but they are not persuasive.

Applicant argues on pages 3 and 4 that the reference Challenger does not show or suggest the claimed method, that the adhesive in Challenger is completely between the two sheets, that the Wakabayashi reference discloses a similar method and is deficient for the same reasons, and that the Duck reference also does not disclose a second portion that is not disposed from between the articles. Again, it is noted that Applicant's recitation that the adhesive **is not disposed from between** the driveshaft and the balance weight is unclear. It appears that a portion of adhesive that is only between the balance weight and the driveshaft and does not extend from between the two articles reads on this limitation. If this is the case, then the Admitted Prior Art and the conventional state of the art as evidenced by Duck, Challenger and Wakabayashi clearly show a second portion between the two articles to be bonded. On the other hand, if Applicant intends to recite that the second portion of adhesive is not between the driveshaft and the balance weight, then this reads on excess adhesive that is squeezed out from between the driveshaft and balance weight when they are pressed together. This all the arguments recited in prior Actions about the curing of excess adhesive that is not between the two articles applies and is repeated.

It is well known and recognized in the bonding art when bonding two articles together with adhesive to allow the adhesive to protrude or extrude from the peripheral surface portions of the article and that these portions of the adhesive tend to dry first. It is also well recognized that the dry protruded or extruded portions of adhesive temporarily hold the articles together prior to the curing or drying of the other portions of adhesive. Only the expected results are attained by allowing such portions to cure prior

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to the portions of adhesive between the articles. Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention to cure the extruded portions in order to temporarily hold the articles together for further processing until total curing is achieved as is conventional state of the art and exemplified by the references Duck, Challenger and Wakabayashi in order to speed up the manufacturing process.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gladys J. Piazza whose telephone number is (703) 305-1271. The examiner can normally be reached on M-F 8am-5:30pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on (703) 308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Gladys Piazza
June 11, 2002


Michael W. Ball
Supervisory Patent Examiner
Technology Center 1700